54. (New) The method according to Claim 41, wherein the composition having neurotrophic activity comprises BMP-7 and NT-3.

55. (New) The method according to Claim 41, wherein the composition having neurotrophic activity comprises BMP-12 and NT-3.

56. (New) A method according to Claim 41, wherein the central nervous system disorder is Parkinson's disease, Alzheimer's disease, ALS or other demetia, other neurodegenerative disorders of the central nervous system and peripheral neuropathies including diabetes, cisplatinum or other genetic or acquired peripheral nerve diseases.

REMARKS

In the Claims

Claim 1 has been amended to more particularly define that which Applicants regard as their invention. Claims 2-16 have been amended to contain language consistent with Claim 1 upon which they depend. Deletion of the word "EGF" in Claim 2 corrects a typographical error.

Restriction Requirement

Responsive to the Restriction Requirement, Applicants provisionally elect to prosecute the claims of Group III (Claims 1-2, 5 and 16), drawn to a pharmaceutical composition comprising GDNF and TGF-β. Applicants reserve the right to file a divisional or continuing application, or take such other appropriate action as deemed necessary to protect the inventions of Groups I, II and IV-XIII. Applicants do not hereby abandon or waive any rights in the Groups I, II or IV-XIII inventions. This election is being traversed for the reasons set forth below.

The necessary criteria for a proper restriction requirement are clearly defined. Each restriction must meet two separate requirements. The criteria are described in the Manual for Patent Examining Procedure (MPEP) at §803, in relevant part, as follows:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent . . . or distinct as claimed; and

(B) There must be a serious burden on the Examiner if restriction is required . . .

The Examiner has stated that the inventions are distinct, each from the other because each of the inventions listed encompasses a unique combination comprising physically and functionally distinct chemical entities, thus non-coextensive searches are required. Applicants respectfully disagree. The chemical entities of the claims all share the classification of cytokines, and the claimed combination of these cytokines share the function of neurotrophic activity. The common function of these cytokines, namely neurotrophic activity, does not render these cytokines distinct in the claimed invention. Since the inventions are not distinct, but instead have identical function, they should not require restriction.

Furthermore, the claims of all thirteen groups have been placed by the Examiner in the identical class and subclass: class 424 and subclass 198.1. Claims 1 and 2 are contained in each of the Groups proposed for restriction. Claims 3-16, which have been individually separated into Groups I-XIII respectively for restriction, all have dependence on Claim 1. Claim 1 recites the cytokines that are represented in dependent claims 3-16. Therefore, it is the view of the Applicants that a proper search and examination of Claims 1 and 2, which are present in all Groups for election, must also necessarily include a search and examination of Claims 3-16. The concurrent examination of Groups I-XIII can place no additional burden on the Examiner.

In conclusion, as all claims are classified identically, and all claims share an identical function, it must be concluded that no serious burden would be placed on the Examiner by concurrent examination of Groups I-XIII of the application. In contrast, Applicants will be burdened with a serious loss of patent term if the restriction requirement is maintained.

Applicants traverse the requirement for restriction and respectfully request that it be withdrawn, and that the claims of Groups I-XIII be rejoined and examined in the application.

Submission of the Preliminary Amendment

Applicants respectfully request entry of the concurrently submitted Preliminary Amendment to include new Claims 17-56. These new claims cover methods of using the compositions claimed in Claims 1-16. Support for the amended and new claims can be found in the Specification, for example, page 3, lines 20-24; page 6, lines 3-5; page 6, lines 9-12; page 12, line 24 - page 13, line 8; page 13, lines 13-16; and page 14, lines 2-5. No new matter has been added. Entry is respectfully requested.

The entry of this Preliminary Amendment would not place an additional burden on the Examiner in terms of search and examination. As stated above, these claims cover methods of use of the compositions of Claims 1-16. Conducting a search on the subject matter of Claims 1-16 would necessarily entail conducting a search on the new Claims 17-56, and therefore cannot create an undue burden on the Examiner.

Alternatively, if the Examiner maintains the Restriction Requirement and does not recombine the claims of Groups I-XIII, Applicants still respectfully request entry of the Preliminary Amendment with the understanding that only the method of use Claims 17, 18, 21, 32-42, 45, and 56 that refer to the uses of the composition of GDNF and TGF-β would be examined with the composition claims of Group III.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (781) 861-6240.

Respectfully submitted,

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Dated: July 9, 2001

MARKED UP VERSION OF AMENDMENTS

Claim Amendments Under 37 C.F.R. § 1.121(c)(1)(ii)

What is claimed is:

1. (Amended) A [pharmaceutical] composition having neurotrophic activity, comprising a biologically active amount of at least two cytokines or functionally active derivatives or parts thereof wherein at least one of said cytokines is BMP, GDF, TGF-ß or GDNF.

2. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, wherein the cytokines are selected from the group consisting of GDF, GDNF, TGF, activin A, BMP, BDNF, NGF, NT, EGF, [EGF,] CNTF and FGF.

3. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising GDF-5 and NGF.

4. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising GDF-5 and NT-3.

5. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising GDNF and TGF-β.

6. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising GDF-5 and GDNF.

7. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising TGF-β and FGF-2.

8. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising TGF-β and CNTF.

9. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising TGF-β and NT-3.

10. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising TGF-β and NGF.

11. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising BMP-4 and NGF.

12. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising BMP-12 and NGF.

13. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising BMP-2 and NT-3.

14. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising BMP-7 and NT-3.

15. (Amended) The [pharmaceutical] composition having neurotrophic activity according to Claim 1, comprising BMP-12 and NT-3.

16. (Amended) The [pharmaceutical] composition having neurotrophic activity of Claim 1 further comprising a pharmaceutically acceptable carrier, diluent or any combination thereof.